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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1033-A00498-C	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>May 22, 2006</u> Signature <u>Esther H. Yu</u> Typed or printed name <u>Esther H. Yu</u>		Application Number 10/621,127	Filed July 16, 2003
First Named Inventor Theodore James Myers		Art Unit 2687	
Examiner DOAN, Phuoc Hieu		Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.	
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,342</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>Jeffrey G. Toler</u> Typed or printed name Jeffrey G. Toler Telephone number <u>512-327-5515</u> Date <u>5-22-2006</u>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Theodore James Myers, et al.

Title: OVER THE AIR USER ZONE ASSIGNMENT FOR WIRELESS
TELEPHONY SYSTEMS

App. No.: 10/621,127 Filed: July 16, 2003

Examiner: DOAN, Phuoc Huu Group Art Unit: 2687

Atty. Dkt No.: 1033-A00498-C Confirmation No.: 1949

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Final Office Action mailed on March 7, 2006 (hereinafter, "Final Office Action"), Applicants file herewith a Notice of Appeal and a Pre-Appeal Brief Request for Review. Applicants request review of the following issues.

Claims 18-33 and 38-40 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Owensby, U.S. Pat. Pub. No. 2002/0077130 ("Owensby"), in view of Sato, U.S. Pat. No. 6,009,403 ("Sato"). Applicants respectfully traverse the rejection of claims 18-33 and 38-40.

Claims 18-30 are allowable

Claim 18, from which claims 19-30 depend, recites "a mobile terminal comprising a graphical user interface to receive user inputs to define a user zone, the user zone comprising a desired area of operation to subscribe to wireless service options." The Final Office Action states that Owensby discloses this feature at p.7, paragraph [0046]; p. 6, paragraph [0045] and p. 12, paragraph [0080]. *Final Office Action*, p.3, 2nd paragraph. Applicants respectfully disagree.

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Owensby deals generally with targeting messages to a subscriber based on a location of a wireless mobile terminal. *Owensby*, Abstract. Owensby at paragraph [0045] states:

The Wireless Mobile Location Data determines the real-time, physical location of the wireless mobile terminal 12 within the operator's wireless network service area at the time that the wireless mobile communication is initiated or received. As used herein, the term "wireless mobile location" refers to the real-time, physical location of the wireless mobile terminal 12 at the time that the wireless mobile communication is initiated or received by the terminal. *Owensby*, pp.6-7, paragraph [0045] (emphasis added).

That is, Owensby discloses a wireless mobile location that is the actual, physical, real-time location of a user's mobile terminal. The method of Owensby is clearly intended to function with a service area defined by the operator, i.e., within the operator's wireless network service area. *See e.g.*, *Owensby*, p.6, paragraph [0044]; pp.6-7, paragraph [0045]; and p.7, paragraph [0049]. The operator of Owensby is the service provider. *Owensby*, p.1, paragraph [0003]. Thus, neither the wireless mobile location nor the wireless network service area of Owensby discloses or suggests a user zone comprising a desired area of operation to subscribe to wireless service options, as recited in claim 18. Further, neither the wireless subscriber service area, nor the wireless mobile location is received as user inputs into a graphical user interface of the mobile terminal. In contrast to claim 18, the wireless mobile location of Owensby is automatically transmitted by the mobile terminal as a location signal. *Owensby*, p.7, paragraph [0046]. The wireless network service area is determined based on the operators hardware infrastructure. *See, Id.* Thus, neither the wireless mobile location nor the wireless network service area of Owensby discloses or suggests a mobile terminal comprising a graphical user interface to receive user inputs to define a user zone, as recited in claim 18. The Final Office Action does not allege that Sato discloses or suggests a mobile terminal comprising a graphical user interface to receive user inputs to define a user zone, the user zone comprising a desired area of operation to subscribe to wireless service options, and indeed, Sato does not disclose this feature.

The Final Office Action also fails to establish a prima facie case of obviousness with regard to claim 18 because there is no motivation to make the asserted combination. The Final Office Action states as its rationale for making the combination "to provide an information retrieval system in precisely information based on the geographical." *Final Office Action*, p.4, 1st

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paragraph. Both Sato and Owensby disclose methods of determining precise geographic locations. *See e.g., Sato*, Abstract (relating to GPS navigation) and *Owensby*, pp.6-7, paragraph [0045]. However, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Logically, a feature already included in each reference could not motivate combining the references because either reference standing alone already includes the feature.


The Final Office Action, therefore, fails to establish a prima facie case of obviousness with regard to claim 18 because each feature of claim 18 is not disclosed or suggested by the asserted combination of Owensby and Sato and because there is no teaching or suggestion to make the asserted combination. Claim 18 is therefore allowable. Additionally, claims 19-30, which depend from claim 18, are also allowable at least in light of their dependence from claim 18.

Conclusion

In light of the arguments presented above, the rejections of claims 18-30 are improper, and the Applicants respectfully request withdrawal of the rejections. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

5-22-2006
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant
TOLER SCHAFFER, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 327-5575 (fax)